

03190.000100.



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: Julianna Nancy Harvey
EDDIE F. RAY, III ET AL.	)	
	:	Art Unit: 3733
Appln. No.: 10/766,504	)	
	:	Confirmation No.: 3501
Filed: January 27, 2004	)	
	:	
For: BONE GRAFTS	)	December 1, 2008

The Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PETITION, UNDER 37 C.F.R. § 1.144, FOR REVIEW  
OF FINAL REQUIREMENT OF RESTRICTION

Sir:

Applicants hereby petition, under 37 C.F.R. S 1.144, for review of the final requirement of restriction dated May 30, 2008, in the above-identified patent application, as follows. Please charge any fee that may be required in connection with filing of this petition to our Deposit Account No. 06-1205.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

December 1, 2008

(Date of Deposit)

RONALD A. CLAYTON

(Name of Attorney for Applicant)

Ronald A. Clayton

Signature

December 1, 2008

Date of Signature

I. STATEMENT OF FACTS

A. The Subject Application

The subject application is directed generally to bone grafts, which in preferred embodiments may be used to fuse adjacent vertebrae in the spine to provide stabilization of the spinal column. All claims in the subject application, numbers 1 to 66, were presented for the purpose of provoking an interference with U.S. Patent No. 6,511,509 (Ford, et al.). More particularly, these claims were copied either identically or in modified form from Claims 1 to 10, 13, 16, 17, 20, and 22 to 25 of the Ford Patent.

B. The Restriction Requirement

An Office Action, dated December 13, 2007, required restriction of further prosecution of the subject application to claims of one of the following groups:

- Group I: Claims 1-15, 19-46, and 50-66, drawn to a bone allograft;
- Group II: Claims 16, 18, 47, and 49, drawn to a method for restoring vertical support; and
- Group III: Claims 17, 18, 48, and 49, drawn to a method of making an allograft.

An election-of-species requirement, requiring Applicants to elect a single species from those listed below, was also imposed.

- A. Figure 1;
- B. Figures 3-4;
- C. Figures 5-6;
- D. Figures 7-8;
- E. Figure 11;
- F. Figure 12;
- G. Figure 13;
- H. Figures 14-17;
- I. Figure 18;

- J. Figures 19-20;
- K. Figure 21;
- L. Figure 22;
- M. Figure 23;
- N. Figures 24-25;
- O. Figure 26;
- P. Figure 27;
- Q. Figure 28;
- R. Figure 29;
- S. Figures 30-32; and
- T. Figures 33-36.

In a Response to Restriction Requirement dated March 13, 2008, Applicants provisionally elected to prosecute Group I, comprising Claims 1 to 15, 19 to 46 and 50 to 66 directed to a bone allograft. The restriction requirement was, however, traversed and reconsideration of it was requested.

Applicants further elected Specie F (Figure 12), on which at least Claims 1, 2, 3, 4, 6, 7, 12, 13, 15, 20, 23, 26, 28, 31, 32, 33, 34, 35, 37, 38, 43, 44, 51, 54, 57, 65, and 66 are readable, for initial prosecution on the merits.

## II. ARGUMENT

To reiterate, all claims in the subject case were presented for the purpose of provoking an interference with the Ford Patent and were copied either identically or in modified form from Claims 1 to 10, 13, 16, 17, 20, and 22 to 25 of that patent.

Claims 1 to 21 of the Ford Patent are directed to a bone allograft and correspond to Group I, Claims 1 to 15, 19 to 46, and 50 to 66 of the subject application; Claims 23 and 25 of the Ford Patent are directed to a method of restoring vertical support and correspond to Group II, claims 16, 18, 47 and 49 of the subject application; and Claims 24 and 25 of the Ford Patent are directed to a method of making a bone allograft and correspond to Group III, Claims 17, 18, 48 and 49 of the subject application. Thus, the

Ford Patent issued with claims in the same three groups to which restriction was required in the subject case. Moreover, when filed, U.S. Patent Application No. 09/073,897 issuing as the Ford Patent, presented claims in each of these three groups, yet at no point in prosecution was a restriction requirement made by the Patent and Trademark Office in that application. Therefore, Applicants submitted that it was inappropriate and unfair to restrict prosecution in this case to three groups of claims that were consistently examined together and ultimately issued together in the Ford Patent.

Applicants also submitted that dividing prosecution in the subject application to separate examination of three groups of claims would be unnecessarily inefficient and cumbersome for the Patent and Trademark Office. Again, the subject application was filed in order to provoke an interference with the Ford Patent. If finality of the restriction requirement is ultimately upheld, then the subject application will be divided into three applications, in each of which the Applicants will request an interference; three applications in which the Patent and Trademark Office will be required to consider whether to declare an interference; and if in each case an interference is declared, three interferences all against the same patent to Ford. Applicants submit that such a result and consequent procedures would be undesirable to both the Examiner and the Board of Patent Appeals and Interferences.

In the Official Action making the restriction requirement final, the Examiner considered these arguments but found them unpersuasive. Despite examination by the PTO of all three groups of claims in one application issuing as the Ford Patent, without objection, the Examiner suggested that such examination was burdensome then and is burdensome now. The Examiner also asserted that because the present claims must

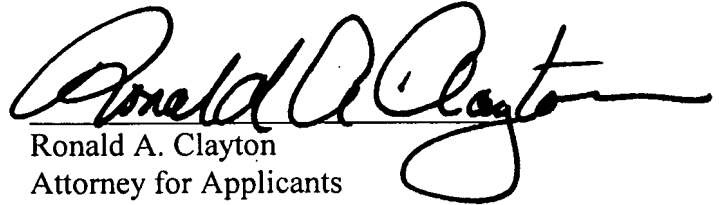
first be examined and found allowable, even though they were allowed to Ford, does not guarantee that the subject case will proceed to interference.

On the latter point, the Examiner is correct. However, Applicants nevertheless submit that the path of prosecution likely to be most efficient to the PTO and to the parties, and therefore the least burdensome to all, is to examine all three groups of claims in the subject application together, rather than separately. While initially this path requires additional expenditure of resources, such expenditure would be far less than having all three groups or even perhaps only two groups proceeding to allowance and then to separate interferences. Efforts of the Board of Patent Appeals and Interferences would be expanded two or three times compared to prosecution of a single interference. It is respectfully submitted that such possible multiple contested proceedings will consume far more resources of the PTO and the parties than would a single examination of the subject application now.

Accordingly, for the reasons set forth above, Applicants respectfully petition for reconsideration and withdrawal of the restriction requirement, and examination of all claims in the subject application together.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Ronald A. Clayton", written over a horizontal line.

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